

## REMARKS

In the Final Office Action mailed on October 1, 2009 and the Advisory Action mailed on December 15, 2009, all of pending claims 1-6, 9-21 and 26-28 stand rejected.

With this Amendment claim 2 has been cancelled and new claims 29 and 30 have been added. Claims 29 and 30 are fully supported by the application as filed.<sup>1</sup>

Reconsideration of the pending claims in view of the following remarks is respectfully requested.

### I. 35 U.S.C. 102 Rejections

Claims 1-6, 9-15, 18-21 and 26-27 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/47974 (“Heyenk”) or, in the alternative, rendered obvious over Heyenk.

Independent claims 1 and 20 recite a can (claim 1), or a method of making a can (claim 20), in which at least one body or end portion is coated with a coating composition that includes a blend of polyesters including between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C and between 10 and 40 weight percent of polyester resin having a Tg greater than 50°C. Heyenk does not disclose such a polyester blend.

In contrast, Heyenk exemplifies polymer blends that include a substantial majority of polymer having a Tg greater than 45°C (i.e., 45-50°C)<sup>2</sup> and teaches that the polymer blends preferably include at least 50% of such polymer. Heyenk does not disclose a single polyester blend that includes either (i) a polyester having a Tg greater than 50°C or (ii) between 60 and 90 weight percent of polyester having a Tg less than 25°C. In fact, 37 weight percent is the highest concentration of polyester polymer having a Tg of less than 25°C disclosed in Heyenk.<sup>3</sup>

Neither the Advisory Action nor the Final Office Action point to any embodiment of Heyenk that includes between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C. Nonetheless, the Advisory Action asserts that, based on various statements included in Heyenk, a skilled artisan would have inferred the claimed composition. Specifically, the Advisory Action asserts that, based on (i) Heyenk’s statement that “[t]he weight proportion of the polymer having a Tg higher than 45°C is generally at least 25% and preferably at least 50%

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<sup>1</sup> See, e.g., paragraphs 21 and 33 of the published application.

<sup>2</sup> Heyenk does not disclose any polyester materials having a Tg greater than 50°C.

<sup>3</sup> See Applicants’ Response “B” which includes a table on page 8 showing the Tg’s and weight percents of the polyesters included in the coating compositions of the Heyenk worked examples.

(relative to the polymers)<sup>4</sup> and (ii) Heyenk's separate statement that the so called "second polymer" preferably has a Tg of less than 10°C,<sup>5</sup> a skilled artisan would understand Heyenk as disclosing a polyester blend that includes 25% of a polyester having a Tg greater than 45°C and 75% of a polyester having a Tg of less than 10°C.

It is respectfully submitted that the asserted rejection applies an improper anticipation standard. In particular, the Final Office Action and Advisory Action impermissibly pick and choose amongst the various statements of the Heyenk reference to construct a polymer blend consisting only of two particular polyesters and then further postulate a concentration of low Tg polyester in the blend.<sup>6</sup> Again, 37 weight percent is the highest concentration of polyester polymer having a Tg of less than 25°C disclosed in Heyenk. There is no basis for concluding that Heyenk discloses a polymer blend that necessarily includes 75% of a polyester polymer having a Tg less than 10°C. This is evidenced by the fact that the Heyenk reference itself teaches that (i) the polymer blend can include polymers other than polyester polymers,<sup>7</sup> (ii) the polymer blend can include more than two polymers and/or more than one polymer having a Tg greater than 45°C,<sup>8</sup> (iii) the polymer blend preferably includes more than 50% of a polymer having a Tg greater than 45°C,<sup>9</sup> and/or (iv) the "second polymer" can have a Tg greater than about 25°C.<sup>10</sup> Accordingly, the instant claims are not anticipated by Heyenk.

With regards to the alternate obviousness rejection, neither the Final Office Action nor the Advisory Action provide any reasoning as to what result(s) a skilled artisan would have sought to achieve in contradicting the preferred teachings of Heyenk and including between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C, let alone why a

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<sup>4</sup> See Heyenk at page 3, lines 21-24.

<sup>5</sup> See Heyenk at page 2, lines 28-30.

<sup>6</sup> For a reference to be anticipatory, it must disclose each and every element recited in the claims and must disclose the elements as arranged in the claims. (See MPEP 2131.) According to the Federal Circuit, because the hallmark of anticipation is prior invention, "[T]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." See *Net Moneyin, Inc., vs. Verisign, Inc.*, \_\_\_\_\_ (Fed. Cir. 2008) slip opinion at page 19, quoting *In re Akley*, 455 F.2d 586, 587 (CCP 1972). Bracketing in original.

<sup>7</sup> Heyenk discloses that polyesters and polyacrylates are examples of suitable polymers for use in the mixture. See page 2, lines 2-4.

<sup>8</sup> Heyenk teaches that the resin system that contains a mixture of at least two polymers wherein at least one polymer has a Tg greater than 45 °C. See, e.g., the Abstract; page 2, lines 29 through page 3, line 2; and claim 1.

<sup>9</sup> See Heyenk at page 3, lines 21-23.

<sup>10</sup> Heyenk discloses that the second polymer has a Tg generally lower than about 40°C, but can have a Tg of 40°C or more. See, e.g., page 2, lines 23-27.

skilled artisan would have sought to achieve any such result(s) or have had a reasonable expectation of achieving any such result(s).

In view of the foregoing, it is respectfully submitted that Heyenk neither anticipates, nor renders obvious, any of the pending claims.

## **II. 35 U.S.C. 103 Rejections**

### **A. Heyenk in view of Parekh**

Dependent claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heyenk in view of U.S 6,235,102 (“Parekh”). The Final Office Action acknowledges that Heyenk does not disclose the addition of an acrylate copolymer having glycidyl groups and looks to Parekh to overcome this deficiency in Heyenk. However, even *arguendo* if the proposed combination were made, the resulting coating composition would not include all of the features of independent claim 1 from which claims 16 and 17 depend.<sup>11</sup> For example, neither reference discloses a composition including a blend of two or more polyesters having between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C. It is accordingly submitted that claims 16 and 17 are allowable over Heyenk and Parekh.

### **B. Heyenk as evidenced by Parekh in view of Maska**

Claim 28 stands rejected as being obvious over Heyenk as evidenced by Parekh in view of U.S. 5,252,669 (“Maska”). The Final Office Action acknowledges that the primary Heyenk reference is silent regarding the use of a phenoplast for cross-linking and looks to Maska to overcome this deficiency. Even *arguendo* if the proposed combination were made, the resulting coating composition would not include all of the features of independent claim 1 from which claims 16 and 17 depend.<sup>12</sup> As discussed above, neither Heyenk nor Parekh discloses a composition including a blend of two or more polyesters having between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C. Maska does not overcome this deficiency in Heyenk and Parekh. It is accordingly submitted that claim 28 is allowable over Heyenk, Parekh, and Maska.

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<sup>11</sup> Applicants traverse the assertion that a skilled artisan would have been motivated to make the proposed combination.

<sup>12</sup> Applicants traverse the assertion that a skilled artisan would have been motivated to make the proposed combination.

### **III. New Claims**

New claims 29 and 30 are allowable over the cited references for at least the same reasons as discussed above for claims 1-6, 9-15, 18-21 and 26-27.

### CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of pending claims 1, 3-6, 9-21, and 26-30 are in condition for allowance. A notice to that effect is respectfully requested. The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 50-2070.

Respectfully submitted,

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